

### REMARKS

Claims 1-14 remain pending in this application. Claims 1-14 are rejected. Claims 1 and 8 are amended herein to clarify the invention, to express the invention in alternative wording, to broaden language as deemed appropriate and to address matters of form unrelated to substantive patentability issues.

Applicant herein traverses and respectfully requests reconsideration of the rejection of the claims cited in the above-referenced Office Action.

The applicant and applicant's attorney appreciate the Examiner's granting of the telephone interview conducted on March 29, 2011, and extend their thanks to the Examiner for her time and consideration.

While no formal agreement was reached, the Examiner indicated that she would give careful consideration to the arguments presented by applicant's counsel. It was agreed, in principle, that the respective substitution of the term "stretchability" for "shrinkage," and the term "stickingly applicable" for "contactably receivable" was deemed preferable, as both of these substituted terms appear literally in the specification as originally filed.

The arguments presented by applicant's counsel during the course of the interview are repeated herein with respect to each of the rejections, as requested by the Examiner.

Claims 1-14 are rejected under 35 U.S.C. § 112, first paragraph, for containing subject matter allegedly lacking an adequate written description in the specification. Applicant herein respectfully traverses this rejection.

The first point of contention raised by the Examiner relates to the alleged lack of claim recitations relating to precise materials used in fabricating the claimed body sticking sheet. Applicant respectfully submits that, since any suitable material demonstrating the claimed characteristics of different degrees of stretchability in respective first and second portions, applicant is under no obligation to unnecessarily limit the scope of the claims to any one type of material, such as for example, elastic fabric. The Examiner acknowledges that "the specification makes some specific reference to fabrics or cloth." (See page 6, first full paragraph of the Office Action). Applicant knows of no requirement to limit claims by importing limitations in the specification relating to specific embodiments, and therefore respectfully submit that, in this regard, the claims properly conform to the written description requirement of Section 112, first paragraph.

As noted by the applicant in the previous response, one skilled in the art is fully familiar with various available fabrics and the like which possess physical characteristics which would be suitable for use in implementing the claimed invention. This knowledge is exemplified quite clearly by specific reference in the instant specification to "a taping tape wherein the whole of the cloth or the similar material is made of the same raw material and in the same weaving manner, and thus

all the area of the taping tape has an even degree of shrinkage," reference being made to an example disclosed in a Japanese Patent Application. (see paragraph bridging pages 2 and 3, emphasis added). Therefore, it is apparent that one skilled in the art, proceeding from this state of the art, would be able to select a fabric, for example, with a desired degree of shrinkage (stretchability) and one with a lesser degree of shrinkage (stretchability) for use in a different region of the claimed body sticking sheet very easily, and that the applicant was, therefore, in full possession of the claimed subject matter at the time of the invention.

The Examiner further takes issue with claims 7-14, stating that the subject matter thereof does not comply with the written description requirement. While the Examiner admits that "there is evidence of an adhesive on the body sticking sheet," she is of the position that there is no support for the claimed recitation "that the adhesive is on both the first and second portions." (See page 5 of the Office Action). As presented by applicant's counsel during the above-referred interview, paragraph [0009] of the published application states that "the portion with a small degree of shrinkage is stuck on the body." (Emphasis added). Thus, it is clear that not only is the outer, more stretchable portion of the body sticking sheet stuck on the body, but also the region with the smaller degree of stretchability. Thus, full support for the claimed subject matter of claims 7 and 8 is found in the written description.

Therefore, reconsideration of the rejection of the claims and their allowance are earnestly requested.

Claims 1-14 are rejected as indefinite under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter of the invention as a result of informalities stated in the Office Action.

Applicant respectfully submits that the Examiner's understanding of what constitutes a "relative" term, which is indefinite, is incorrect. Terms such as "small" and "large" are of a type which are considered to be "relative," since these are subjective in nature, and do not describe qualities in concrete terms. Since, what one would consider "large" or "small" would vary from observer to observer, it would be impossible to objectively ascertain whether a claim is infringed by an article of manufacture, thereby rendering the claim using such terminology indefinite. This is quite different from the entirely permissible practice of relating one quality or quantity to another, in a manner which allows an objective observer to tell, with certainty (i.e., definite), whether the claim reads on a suspected infringing article. In the instant case, there is nothing indefinite in reciting an interrelationship between the first and second portions in terms of related degrees of stretchability, since no one could arrive at a different conclusion as to whether an article suspected of infringing the claims had a second portion with greater stretchability greater than the first portion.

The other terms serving respectively as a basis of indefiniteness relating to "contactably receivable" and "adhesively receivable" have been addressed by applicant by appropriate amendment.

Therefore, based on the foregoing, reconsideration of the rejection of claims 1-14 and their allowance are earnestly requested.

Claim 1 is rejected under 35 U.S.C. § 102(b) as being anticipated by Gordon (US 3,329,143). Applicant herein respectfully traverses this rejection. "Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*" ***Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.***, 221 USPQ 481, 485 (Fed. Cir. 1984) (emphasis added). It is respectfully submitted that the cited reference is deficient with regard to the following.

Claim 1 is amended, and recites in pertinent part the following:

a first portion having a first degree of stretchability, said first portion being stickingly applicable to the affected area; and

a second portion surrounding the first portion, said second portion including a second degree of stretchability and being stickingly applicable to a portion of the body region surrounding the affected area, said second degree of stretchability being 2 to 20 times greater than said first degree of stretchability,

said second portion being expandable and contractible  
radially with centering on the first portion.

Applicant respectfully submits that the Gordon reference fails to teach or suggest such features. For example, the Gordon reference is devoid of teaching that the bandage (being equated with the first portion by the Examiner) is “stickingly applicable to the affected area.”

Claim 1 particularly describes and distinctly claims at least one element not disclosed in the cited reference. Therefore, reconsideration of the rejection of claim 1 and its allowance are respectfully requested.

Claim 1 is rejected under 35 U.S.C. § 102(b) as being anticipated by JP 6339495 (hereinafter JP '495). Applicant herein respectfully traverses this rejection.

The Office Action admits that the JP' 495 reference “does not explicitly teach an adhesive in its first portion,” as is recited in the rejected claim by the recitation “stickingly applicable.”

Claim 1 particularly describes and distinctly claims at least one element not disclosed in the cited reference. Therefore, reconsideration of the rejection of claim 1 and its allowance are respectfully requested.

Claims 7-9 are rejected as obvious over JP '495 under 35 U.S.C. §103(a). The applicant herein respectfully traverses this rejection. For a rejection under 35

U.S.C. §103(a) to be sustained, the differences between the features of the combined references and the present invention must be obvious to one skilled in the art.

As noted above, the Examiner admits that the JP' 495 reference "does not explicitly teach an adhesive in its first portion" (see page 12 of the Office Action, penultimate paragraph). It is applicant's position, as expressed during the course of the interview, that the very nature of bandages is to specifically avoid the presence of adhesive in the region of a gauze portion, so as to intentionally prevent adhesion to the wound it covers. Therefore, one would be lead away from the claimed invention, which recites that the first portion is "stickingly applicable" to the affected area.

Consideration must properly be given to teachings of the prior art which would lead one away from the claimed invention as well as those that might suggest the invention. *Mendenhall v. Astec Industries, Inc.*, 13 USPQ2d 1913, 1939 (Tenn 1988), *aff'd*, 13 USPQ2d 1956 (Fed. Cir. 1989).

Thus, it is respectfully submitted that the rejected claims are not obvious in view of the cited reference for the reasons stated above. Reconsideration of the rejections of claims 7-9 and their allowance are respectfully requested.

Claims 1 and 6 are rejected under 35 U.S.C. § 102(e) as being anticipated by Liguori (US Pub. 2003/0023197). Applicant herein respectfully traverses this rejection.

Like JP '495, Liguori is devoid of disclosure directed to a provision by which the alleged first portion (gauze 20) is “stickingly applicable to the affected area,” as claimed.

Claims 1 and 6 each particularly describes and distinctly claims at least one element not disclosed in the cited reference. Therefore, reconsideration of the rejection of claims 1 and 6 and their allowance are respectfully requested.

Claims 3-5, 7-9 and 11-14 are rejected as obvious over Liguori (US Pub. 2003/0023197) under 35 U.S.C. §103(a). Claims 2 and 10 are rejected as obvious over Liguori (US Pub. 2003/0023197) in view of Watanabe et al. (US 6,805,961) under 35 U.S.C. §103(a). The applicant herein respectfully traverses these rejections.

Neither Liguori nor Watanabe et al. teaches that the respective gauze portion (equated with the claimed first portion) is “stickingly applicable to the affected area.” As argued by applicant’s counsel during the interview, and as reiterated again herein, bandages with a gauze portion specifically avoid the provision of adhesive on such gauze portion, so as to intentionally prevent adhesion to the wound it covers. The Examiner has failed to provide any reference directed to gauze bandages that teaches otherwise. Therefore, it is applicant’s position that the cited reference(s) teach away from the claimed invention.

Thus, it is respectfully submitted that the rejected claims are not obvious in view of the cited reference(s) for the reasons stated above. Reconsideration of the rejections of claims 2-5 and 7-14 and their allowance are respectfully requested.



A Request for Continued Examination (RCE) is being filed concurrently herewith, in which the applicant requests a one (1) month extension of time for responding to the Office Action.

The USPTO is hereby authorized to charge any fee(s) or fee(s) deficiency or credit any excess payment to Deposit Account No. 10-1250.

In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited.

Respectfully submitted,  
JORDAN AND HAMBURG LLP

By Frank J. Jordan by:  
Frank J. Jordan  
Reg. No. 20,456  
Attorney for Applicant  
and,

By Lawrence J. Wechsler  
Lawrence J. Wechsler  
Reg. No. 36,049  
Attorney for Applicant

Jordan and Hamburg LLP  
122 East 42nd Street  
New York, New York 10168  
(212) 986-2340

enc: Request for Continued Examination (RCE).